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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/634,947 | 08/07/2000 | James Pei-Man She | 016660-049 | 2827 |

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BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
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EXAMINER

LIM, KRISNA

ART UNIT PAPER NUMBER

2153

DATE MAILED: 03/11/2004

to

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,947

Applicant(s)

SHE ET AL.

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment filed 9/24/03 and 12/23/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-10,14,15 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 3-6, 11-13, 16-19 and 24-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-28 are pending for examination in the application. Of the above claims 26-27 are withdrawn from consideration.

2. Applicant's election without traverses of Invention I, claims 1-25 and 28 in Paper No. 12 is acknowledged.

3. Claims 1-2 and 14-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Burns et al. [U.S. Patent No. 6,324,182] in view of Haggerty et al. [U.S. Patent 6,331,983]. This rejection is incorporated from paragraphs 8-10 of the previous rejection mailed 9/24/03.

4. Claims 7-8 and 20-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Yates et al. [U.S. Patent No. 6,167,438] in view of Haggerty et al. [U.S. Patent 6,331,983]. This rejection is incorporated from paragraphs 19-23 of the previous rejection mailed 9/24/03.

5. Claims 9-10, 22-23 and 28 are rejected under 35 U.S.C. § 103 as being unpatentable over Yates et al. [U.S. Patent No. 6,167,438] in view of Haggerty et al. [U.S. Patent 6,331,983] and further view of Lin et al. [U.S. Patent No. 6,405,256]. This rejection is incorporated from paragraphs 24-26 of the previous rejection mailed 9/24/03.

6. Claims 3-6, 11-13, 16-19 and 24-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. And, the previous rejection of those claims in paragraphs 11-18, 27-32 have been withdrawn.

7. The rejections are respectfully maintained and incorporated by reference as set forth and detail as indicated in paragraphs 3-6 above.

8. Applicant's arguments filed 9/24/03 have been fully considered but they are not deemed to be persuasive.

In the remarks, in response to claims 1-2, 14 and 15 on pages 12-14, applicants argued that:

a) Burns requires a prediction to be made in advance of the content required, which is unlikely to be very accurate. This is contrast to the Applicants' invention which is not a mirror or cache server approach, but which provides a network in which a gateway can search for the content from the nearest source dynamically as and when required.

b) The Applicants' invention does not use IP multicast to achieve the same purpose of supplying a second and subsequent client with a data stream already being supplied to a first client. The gateways of the Applicants' invention achieve effective one-to-many (similar but not the same as IP multicast) without relying on IP multicast capability which may be lacking in some network environments such as conventional Internet Service Providers, and indeed the Internet generally.

c) The Haggerty patent is specially concerned with the ability to provide multicast traffic in a switch-based network. See col. 7 (lines 5-20). There is no apparent reason why a person of ordinary skill in the art would be motivated to apply its teachings to the system of the Burns patent. Specially, there is no teaching in either reference that suggests the use of multicast transmission for the delivery of streaming data from a content provider. Only Applicants' disclosure provides a teaching of such concept.

In the remarks, in response to claims 7, 8, 20 and 21 on page 17-21, applicants argued that::

d) there are no teachings in either the Yates patent or the Haggerty patent that would lead a person of ordinary skill in the art to combine them. First, as is apparent from its cover figure, the Yates patent discloses a router-based network, and therefore would have no need for the specific teachings of Haggerty relating to switch networks. Second, and perhaps more importantly, it is not apparent why one would be inclined to use multicasting the system of Yates. Only applicants have provided any motivation form a combination of these two patents.

e) The neighboring gateways in Yates' include only those along the path back to the home server while in Applicants' invention the neighboring gateways can be along any paths to allow more flexibility and more choices in path selection. In addition, the gateways in the Applicant's invention can handle streaming content that are not cacheable while Yates's cache servers deal only with cached contents.

f) Applicants' invention differs from the router/cache server combination in Yates.

g) In Lin, the choice of neighboring caching server is always the upstream caching server along the pre-selected path (i.e., there is no choice in Lin's invention). In claim 23, the gateway can select from two or more choices.

9. As to paragraph 8 a) to 8 c), such features and arguments are co-extensive to the claimed languages. The claimed language of those claims are not explicitly claimed those features.

10. As to paragraph 8 d) to 8 g), appellant's arguments amount to an attack on the references individually without considering the combined teaching of the references as a whole and what the references together suggest. See In re Keller, 642 F.2d 413, 208 U.S.P.Q 871 (CCPA 1981). Moreover, hindsight has not been used apart from that permitted by the references considered in combination. See, In re McLaughlin, 443 F.2d 1392, 170 U.S.P.Q 209 (CCPA 1971).

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krisna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 7:30 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [glen.burgess@uspto.gov].

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

kl

March 7, 2004



KRISNA LIM
PRIMARY EXAMINER